

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD A. SCHACHAR

Appeal No. 2005-0076
Application No. 09/589,626

MAILED

MAR 24 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to 37 CFR § 41.52, Ronald A. Schachar requests rehearing (i.e., reconsideration) of our decision on appeal rendered November 23, 2004, and more specifically of that portion of the decision affirming the examiner's 35 U.S.C. § 102(b) rejection of claims 1 through 7 and 12 through 17 as being anticipated by U.S. Patent No. 5,354,331 to Schachar.¹

¹ In the decision, we also reversed the examiner's 35 U.S.C. § 101 rejection of claims 1 through 21 and 35 U.S.C. § 103(a) rejection of claims 8 through 11 and 18 through 21.

Consistent with our holding that claims 2 through 7 and 12 through 17 stand or fall with claim 1 for purposes of the appeal (see page 6 in the decision), the appellant's request focuses on claim 1.

In essence, the request rehashes the arguments advanced in the main and reply briefs. Such arguments are no more convincing now than they were before.

The appellant again contends that the Schachar reference is not anticipatory with respect to the subject matter recited in claim 1 because it does not meet the limitation in the claim requiring the recited prosthesis to comprise "a body having a first end and a second end." The relevant portion of the Schachar disclosure (see column 7, lines 1 through 12) describes a prosthesis in the form of a scleral expansion band comprising a strip of metal or synthetic resin having overlapping ends that are slidable past one another by means of a tangential screw mechanism to adjust the circumference of the band and thus the amount by which the sclera is expanded. The appellant submits that this band constitutes a closed circular ring which does not have first and second ends because the overlapping ends of the strip cease to exist after the scleral expansion band is formed.

According to the appellant, claim 1 is "directed to a scleral prosthesis that is not in the form of a closed circular ring" (request, page 3) and would be met by Schachar only if the band disclosed therein were modified or adjusted by being broken up into separate segments. The appellant urges that Schachar does not teach, suggest or provide an enabling disclosure for such a modification.

These arguments fail due to the broad scope of claim 1. As pointed out in the decision,

the recitation in claim 1 that the prosthesis body has a first end and a second end is extremely broad. The claim neither requires the first and second ends to be free and/or unattached nor excludes these ends from being fastened or attached. The appellant's argument to the contrary rests on an improper attempt to read limitations from the specification into the claim [page 5].

Claim 1 also does not exclude the prosthesis recited therein from being in the form of a closed circular ring. The subject limitation in the claim simply calls for the recited prosthesis to comprise "a body having a first end and a second end." Schachar's adjustable prosthesis clearly comprises such a body in the form of the strip of material having first and second ends. These ends do not cease to exist even when the strip assumes its operative configuration. Hence, the Schachar scleral expansion

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band, without any modification or adjustment thereto, fully meets the terms of the claim including the recitation of a body having a first end and a second end.

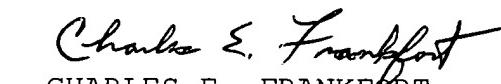
For these reasons, the arguments advanced in the appellant's request for rehearing are not persuasive of any error in our decision.

SUMMARY

In summary, we have reconsidered our decision to the extent requested by the appellant, but decline to make any changes therein.

DENIED


IRWIN CHARLES COHEN)
Administrative Patent Judge)
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CHARLES E. FRANKFORT) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND INTERFERENCES
)


JOHN P. MCQUADE)
Administrative Patent Judge)

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